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IN THE

Supreme Court of the United States

OCTOBER TERM, 1961.

No. 947

THE FULLER BRUSH COMPANY,
Petitioner,

vs.

FULLER PRODUCTS CO.,
Respondent.

On Petition For Writ Of Certiorari To The United States Court Of Appeals For The Seventh Circuit.

BRIEF FOR RESPONDENT IN OPPOSITION

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BRIEF FOR RESPONDENT IN OPPOSITION

This case comes before this Court on petition by The Fuller Brush Company, defendant below, for a writ of certiorari to review the judgment of the United States Court of Appeals for the Seventh Circuit.

OPINIONS BELOW

The opinions below are adequately set forth in the Petition.

JURISDICTION.

The jurisdictional requisites are adequately set forth in the Petition.

QUESTIONS PRESENTED.

The first question presented by the Petition is a question of fact and incorrectly assumes that the particular ultimate fact referred to does not follow as a necessary inference from the circumstantial facts expressly found. Such first question is:

1. May a Court of Appeals determine that the District Court impliedly found an ultimate fact if the circumstantial facts as found by the District Court are not such that the ultimate fact follows from them as a necessary inference?

The second question presented by the Petition is:

2. May a successful plaintiff in a suit for infringement of a trademark be awarded damages when it is not demonstrated that the defendant has been guilty of intentional misleading?

STATUTES INVOLVED.

The statutes involved are adequately set forth in the petition.

STATEMENT OF THE CASE.

Petitioner's "Statement" correctly identifies the parties and the subject matter of the suit. Beyond that, however, petitioner's statement is inadequate. It is so because it intermingles legal arguments and citation of authorities (none of which authorities is referred to later in the petition under the heading "Reasons for Granting the Writ") with fact and even assumes facts contrary to the record and findings below. The findings of fact and conclusions of law are set out below (see Defendant-Appellant's Appendix Vol. II, below, pages 632-641).

In reciting the Findings of Fact and Conclusions of Law by the trial court, the statement in the petition, leaves out pertinent findings and conclusions. These additional findings and conclusions are dealt with in some detail hereinafter by respondent in the argument in this brief and are therefore not specifically set forth here.

There is no dispute in this case as to the requirement of a secondary meaning in a surname as indicated by petitioner in its Statement, on page 6 of the Petition, but the requirements in that respect are not the same as in the case of an overwhelmingly descriptive trademark such as "Shredded Wheat" which was involved in the *Kellogg Co.* v. *National Biscuit Co.*, 1938, 305 U.S. 111, 118, referred to in the Statement, on page 7 of the Petition. In the case of such completely descriptive marks the original meaning is presumed to remain because of the inescapably descriptive character of the mark such that long continued use and even great advertising will not transform them to marks of identification. This is dealt with hereinafter by respondent under the argument Point I(d) of this brief.

The infringement of respondent's food and vitamin trademark by petitioner was wilful and not innocent. Petitioner knew (Defs. Ex. 2, Def's. App., Vol. I, 341) of respondent's prior rights in its "FULLER'S QUALITY" and "FULLER'S" trademarks as applied to foods because it had respondent's 1939 catalogue in its possession showing "FULLER'S Sensational Quality Vitamin B Malted Milk" (Def.'s App., Vol. I, 276) and other foods prior to petitioner's deliberate invasion of the respondent's food (and vitamin) area. The extension of petitioner of the use of its mark to vitamin food supplement was therefore not innocent and any lack of secondary meaning *at the present time* resulting to respondent in the use of its mark specifically applied to vitamins may be ascribed to the deliberate avalanche of use of substantially the same mark on the same goods precipitated by petitioner after the latter's unlawful appropriation. This is dishonest and just as unconscionable as fraud.

ARGUMENT

On First Question Presented

Point I

ALTHOUGH PETITIONER PRESENTS AS ITS FIRST QUESTION, THE PROPRIETY OF A COURT OF APPEALS DETERMINING THAT THE DISTRICT COURT IMPLIEDLY FOUND AN ULTIMATE FACT AS DERIVED FROM CIRCUMSTANTIAL FACTS WHICH THE DISTRICT COURT DID EXPRESSLY FIND, PETITIONER PREDICATES SUCH QUESTION UPON THE FALSE PREMISE THAT THE ULTIMATE FACT IMPLIEDLY FOUND DID NOT FOLLOW AS A NECESSARY INFERENCE FROM THE CIRCUMSTANTIAL FACTS SO EXPRESSLY FOUND.

On page 11, of the petition, Petitioner concedes that:

> "If an ultimate fact follows as a necessary inference from the circumstantial facts which were found by the Trial Court, the petitioner would agree that the Court of Appeals might draw this inference. *United States* v. *Wells*, 1931, 283 U.S. 102, 120, 75 L.Ed. 867, 877."

The ultimate fact which the Court of Appeals determined that the District Court impliedly found from circumstantial facts expressly found was that respondent's trademark "FULLER'S" and "FULLER'S QUALITY" had acquired a secondary meaning indicating respondent as the source of its vitamin products as a necessary inference from the express findings that respondent had a long and substantially exclusive use of its mark on food products and a natural expansion to the prior use of its mark for vitamins.

The pertinent part of the opinion of the Court of Appeals in such determination is as follows (p. 6a of Appendix A attached to brief of petitioner):

> "The Fuller Brush Company argues that plaintiff did not establish that its mark acquired a secondary meaning indicating plaintiff as the source of its vitamin products, and that the District Court made no finding of such secondary meaning. The trial court did not make a specific finding of a secondary meaning in plaintiff, in so many words. The Trial Judge did expressly negative a secondary meaning in The Fuller Brush Company's mark as to vitamin products. There was a finding of long and substantially exclusive use of plaintiff's mark on food products and a natural expansion to the prior use of its mark for vitamins. The District Court concluded that the defendant by spending greater sums in exploitation of its mark as applied to vitamins, after plaintiff's rights had accrued, could not thereby acquire any rights in its mark on vitamins. We agree with the contentions of the plaintiff that there runs through the findings and conclusions, as a whole, the clear implication that the trial court did find that plaintiff's mark had acquired a secondary meaning as to vitamins."

(a) The only reliable facts and evidence thereof from which a secondary meaning may be inferred is long and substantially exclusive use of the trademark upon the particular goods.

(The cases cited by petitioner pertaining to requirements in regard to a secondary meaning have no bearing here as they pertain to trademarks which are presumably incapable of acquiring a secondary meaning because of their overwhelming descriptive character. They are dealt with hereinafter under (d) of this point.)

In *McLean* v. *Fleming*, October 1877, 96 U.S. 245, 254, 255, a finding of long prior use of a personal name mark

upon particular goods was taken as the factual requirement to render it enforceable by injunction (although an accounting was refused but only because of inexcusable laches).

In Callmann, Unfair Competition and Trade-Marks, 2nd Edition, Vol. 3, p. 1237, it is stated:

> "Whether or not a mark has acquired a secondary meaning is a question of fact for the court and is not a proper subject for expert testimony."

and on p. 1238 it further states:

> "It is difficult to prove public reaction by testimony which is sometimes anything but impartial",

citing in footnote 34 cf. *Premier-Pabst Corp.* v. *Elm City Brewing Co.*, 9 F. Supp. 754 (D.C.D. Conn. 1935):

> "To be sure it is not always easy to determine whether in fact the plaintiff has won for himself or his goods any identity which the public recognizes. On this issue, individual members of the purchasing public are frequently called as witnesses and questioned as to their mental reactions. But such testimony, to me at least, is evidence of slight weight for the average individual is seldom a reliable interpreter of his own mental reactions and content." (p. 760).

and further on the same page 1238:

> "A presumption in favor of secondary meaning stems out of a long exclusive use of a trademark, and this has been similarly expressed in the ten-year clause of the Trade Mark Act of 1905 and in Section 2(f) of the Lanham Act"

(Section 2(f) of the Lanham Act permits the Commissioner of Patents to accept as prima facie evidence that the mark has become distinctive as applied to the applicant's goods in commerce, proof of substantially exclusive and continuous use thereof as a mark by the applicant in commerce for five years).

(b) The trial court by its conclusions as well as its findings indicated that it had in mind the requirement of the marks hereinvolved that they must acquire a secondary meaning in respect to the particular goods while at the same time are limited to goods of the same descriptive properties.

In the trial court's Conclusion of Law No. 1 (Def's. App. Vol. II, 638) it held as follows:

> "1. Defendant's registration herein sought to be cancelled, being on the Supplemental Register as a mere surname which had not been used sufficiently to have then acquired a secondary meaning as applied to the particular goods, to wit: vitamins, to become eligible for registration on the Principal Register under Section 2f of the new trademark act, such registration (on the Supplemental Register) constitutes an admission that the mark ('Fuller' in script in the oval) did not at the time of registration constitute a true trade-mark under common law but at most was then at least merely a technical trademark. The doctrine of 'expansion of trade' is not applicable to a trademark requiring a secondary meaning with respect to the goods to which it is applied as such meaning of necessity is closely associated with the particular goods (*Walgreen Drug Stores* v. *Obear-Nester Glass Co.*, 113 F. (2d) 956, 963 (C.C.A. 8) 46 U.S.P.Q. 440)."

Thus the trial court indicated that it had in mind the requirement of the marks hereinvolved that they must acquire a secondary meaning in respect to the particular goods while they are at the same time limited to goods of the same descriptive properties as it further concluded in its Conclusion of Law No. 2 (Def's. App., Vol. II, 639) wherein it held as follows:

> "2. Only a strong (a unique or coined word) trademark is entitled to the benefit of expansion of trade

into non-competing goods and even then it is limited to a reasonable relationship under all the circumstances (3 Callman, Unfair Competition and Trademarks (2 Ed., 1950) at 1594. *W. E. Kautenberg Co. v. Ekco Prods. Co.*, 116 U.S.P.Q. 417). Such is not the case here."

(c) THE TRIAL COURT FOUND IN EFFECT THAT RESPONDENT'S MARK HAD LONG AND SUBSTANTIALLY EXCLUSIVE PRIORITY OF USE UPON FOODS, EXTENDED BY NATURAL EXPANSION TO VITAMINS, OF TWENTY YEARS AT THE TIME PETITIONER EXTENDED ITS USE OF ITS MARK BY NON-NATURAL EXPANSION TO VITAMIN FOOD SUPPLEMENT.

In its Findings Nos. 1, 5 and 8, the trial court found that respondent-plaintiff had used its trademark "FULLER'S QUALITY" and "FULLER'S" since October, 1952, upon vitamins in substantial amounts (Finding No. 1, Def's. App., Vol. II, 632-633); that respondent-plaintiff previous to that had continuously used its said marks upon food products and cosmetics in substantial amount since 1936 (Finding No. 5, Def.'s App., Vol. II, 634); and that respondent-plaintiff's expansion of its business upon which it used its said marks from food products and cosmetics to vitamins in 1952 was a natural one and purchasers would expect a manufacturer of vitamins which are a food to emanate from the same source as those food products when the vitamins also bore the same or similar trademark (Finding No. 8, Def's. App., Vol. II, 636).

The trial court also found (Finding No. 2, Def's. App., Vol. II, 633) that petitioner-defendant, primarily a dispenser of brushes, commenced using its trademark comprising the word "FULLER" in script within an oval and the words "Brush Co." in fine print thereheneath subsequent to November 21, 1955.

The trial court concluded in its Conclusion of Law No. 7 (Def's. App. Vol. II, 640) that "defendant's use of its mark however celebrated upon brushes and like household items prior to plaintiff cannot be deemed to extend to vitamins by any reasonable application of the expansion of trade theory (*Berghoff Brewing Association v. Poppel-Giller Company*, 273 Fed. 328; *Minnesota Mining and Mfg. Co.* v. *Tarrent Mfg. Co.*, 98 USPQ 33, 35 and *S. C. Johnson & Son* v. *Johnson*, 81 USPQ 509)" and further concluded in its Conclusion of Law No. 8 (Def's. App. 640) that since "the mark 'FULLER' in script with the oval, with or without the fine print 'Brush Company' under the word 'FULLER' (or 'FULLER'S QUALITY') of Plaintiff are confusingly similar and the goods (vitamins) are the same, such use by defendant of its said mark is an infringement of Plaintiff's prior rights in its said mark and damage to Plaintiff by defendant's registration and use is presumed."

It is therefore obvious that the trial court considered that respondent-plaintiff's mark had become distinctive of its vitamin goods by long and substantially exclusive twenty years of prior use upon its food products naturally extended to vitamins at the time of petitioner-defendant's wrongful appropriation of its mark upon vitamin food supplement and thus had acquired a secondary meaning as to such products by the only reliable evidence in that respect.

(d) The cases cited by petitioner in connection with its first question have no bearing whatsoever upon the necessary facts and findings to support a secondary meaning in personal name trademarks such as hereinvolved.

For example in *Wilhartz* v. *Turco Products, Inc.*, 7 Cir. 1947, 164 F. 2d. 731, 733, the marks involved were "Auto Shampoo" and "Car Shampoo" which were merely

apt names for the goods and were presumably incapable of acquiring distinctiveness as a source indication regardless of how long or extensively they might be used. In *John Morrell & Co.* v. *Reliable Packing Co.*, 7 Cir. 1961, 295 F. 2d. 314, 317, the mark involved was "E-Z Cut" hams which likewise did little more than define the goods. The latter case cites and follows the "Raisin-Bran" and "Shredded Wheat" cases involving marks of the same character. Thus these cases refer to overwhelmingly descriptive word marks where the original meaning remains predominant because they are comprised of words which are so inescapably descriptive that long continued use and even large expenditures for advertising will not transform such words into marks of identification. See Callmann, Unfair Competition 2nd Ed. Vol. 3, p. 1232:

> "On the other hand, a mark may be so inescapably descriptive that it will defeat all attempts to transform it into a mark of identification and, in such case, even long-continued use and large expenditures will not aid in the search for secondary meaning."

(citing *General Time Instruments Corp.* v. *The United States Time Corp.*, 164 F. 2d. 853 (C.C.A. 2nd 1948) and the "*Raisin Bran*" case, *Skinner Mfg. Co.* v. *General Food Sales Co.*, 52 F. Supp. 432 (D.C. Neb. 1943)).

In conclusion as to the first question presented, it is actually a mere question of fact and there is no conflict between the decisions of the Courts of Appeal because the ultimate fact of secondary meaning in respondent's trademark "FULLER'S" as applied to vitamins impliedly found *necessarily follows* from the long and substantially exclusive use of the mark expressly found upon food products with a natural extension to prior use for vitamins which also was expressly found. That being

so the findings and conclusions of the trial court and the determination of such findings are adequate in respect to the requirements of all of the Courts of Appeal and also the Supreme Court of the United States.

On the Second Question Presented

Point II.

AS FOR THE SECOND QUESTION PRESENTED ON WHETHER OR NOT A SUCCESSFUL PLAINTIFF IN A SUIT FOR TRADEMARK INFRINGEMENT MAY BE AWARDED DAMAGES IN THE ABSENCE OF A FINDING OF INTENTIONAL MISLEADING THIS COURT HAS HERETOFORE HELD THAT IT CAN.

In *Mishawaka Mfg. Co.* v. *Kresge Co.*, 316 U.S. 203, 204, in a case involving no intentional misleading or actual deception but mere reasonable likelihood "that some purchasers might have been induced by the purchaser's belief that he was obtaining petitioner's product" (p. 204), this Court reversed not because there was an award of profits and damages but because the award of profits put the burden on the plaintiff instead of defendant by limiting the profits to sales "to purchasers who were induced to buy because they believed the heels to be those of plaintiff and which sales plaintiff would otherwise have made" (p. 204). This Court in reference thereto said (p. 207):

> "The decree in effect requires the petitioner to prove by a procession of witnesses, that when they bought heels from the infringer they had a clear well-focused consciousness that they were buying the petitioner's heels and that otherwise they would not have bought them. But the shoe is on the other foot."

This Court further awarded damages in addition to profits saying (p. 208):

> "If the petitioner suffered damages beyond the loss of profits the decree should provide for the assessment of such damages."

Thus this Court has held that where the equities require it even in a mere infringement case involving no fraud or intentional misleading the award of both profits and damages is proper.

The other cases cited by petitioner do not apply here. In *Champion Spark Plug Co.* v. *Sanders*, 1947, 331 U.S. 125, the infringement was merely technical in that the accused spark plugs sold by the defendant were of the plaintiff's original manufacture and bore the plaintiff's original trademark but were repaired and resold by the defendant.

In *Saxlehner* v. *Siegel-Cooper Co.*, 1900, 179 U.S. 42, the defendant acted innocently.

Point III.

THE PETITIONER-DEFENDANT IN THE CASE AT BAR DID NOT ACT INNOCENTLY.

Petitioner knew of respondent's use of its trademark "FULLER'S" and "Fuller's Quality" upon foods and cosmetics as far back as January 9, 1942, because it had in its possession respondent's 1939 catalogue (Pl's. Ex. 68, Def's. App. Vol. I, 273-292) illustrating such use upon food products, including on page 4 thereof "FULLER'S SENSATIONAL VITAMIN B MALTED MILK" and other foods and a full line of cosmetics because petitioner on May 9, 1946 wrote a letter (Def. Ex. 2, Def's. App. Vol. I, 3'1) to respondent protesting the fact that the front cover of said catalogue had a picture of a salesman which feature petitioner claimed to have copyrighted. The picture was quite different from that on petitioner's 1936 catalogue (Def. Ex. 1, Def's. App. Vol. I, 293).

At the time that respondent commenced using its trademarks "FULLER'S" and "FULLER'S QUALITY" it

was essentially in connection with a foods and cosmetics business (Pls. Ex. 68, Def's. App. Vol. I, 273-292) whereas petitioner's business in connection with which it used its "FULLER" trademark at that time was essentially a brush business including a few items which are used with brushes such as combs etc. (Def. Ex. 1, Def's. App. Vol. I, pp. 293-339).

Petitioner's extension of the use of its mark "FULLER" to food items (vitamins) in November 1955 or 1956 was therefore *well knowing of respondent's prior rights* and the damage to respondent's food and vitamin business was obvious when one considers the dilution of good will resulting from the tremendous infringing usage by petitioner which it portrays on page 6 of its petition. Petitioner there depicts its dollar value of sales of its "FULLER" vitamins from the last month of 1955 up to October, 1960 as amounting to a total of $12,409,702.70 which dwarfs the dollar value of sales of respondent. According to the might makes right thinking of petitioner this comparison is supposed to be its sword and shield. All this tremendous usage of petitioner's mark upon vitamins according to petitioner, even though it may have diluted respondent's secondary meaning to the point of extinction, it is supposed to also wipe out respondent's long prior rights including the latter's 20 year prior rights of its mark upon food products. Assuming petitioner may have been laboring under a delusion in respect to its rights as a result of such thinking, it would not make it an innocent infringer to the extent that it should not account for its damages or even profits where damages may not otherwise be proven under circumstances such as here.

CONCLUSION

For the reasons set forth above, we submit that the petitioner for a writ of certiorari should be denied.

Respectfully submitted,

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